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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,965	07/24/2003	Paul DiCesare	896P011379-US (PAR)	1641
7590 Geza C. Ziegler, Esq. Perman & Green, LLP 425 Post Road Fairfield, CT 06824-6232				
EXAMINER				
CHEN, VICTORIA W				
ART UNIT		PAPER NUMBER		
3739				
MAIL DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/625,965

Applicant(s)

DICESARE ET AL.

Examiner

VICTORIA W. CHEN

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 11 is/are pending in the application.
4a) Of the above claim(s) 3 and 7-11 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1, 2 and 4-6 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB-08)
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

DETAILED ACTION***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification fails to provide antecedent basis for the common closable jaw.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2 and 4-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant claims the force transmitting member to be connected to a “common closable jaw” and the movement of the lever members causing opening and closing of the common closable jaw [claim 1, ll. 12-21]. However, the specification fails to mention any common closable jaw, or any jaw for that matter, and further fails to disclose how the force transmitting member is connected to the jaw, and how the force transmitting member causes operation of the jaw. Although the original drawings support the medical element [22] being jaw like structures, there is no description about how the force transmitting member is only connected to a single common closable jaw. From the drawings, specifically Figs. 5a and 5b, it appears that

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both jaws are moved when the lever members, not just one. Therefore, for purposes of examination, the examiner interprets the "common closable jaw" claimed to mean a pair of jaws, as seen in applicant's drawings.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Bacher (US 6299625 B1).

Regarding claim 1, Bacher discloses a manual actuating apparatus comprising: a handle [28]; a finger loop [38] mounted on the handle for receiving a finger of an operator; first and second lever members [32, 30] mounted on the handle for grasping engagement by other fingers of the operator, each of the first and second lever members being independently and pivotably mounted on the handle for movement between respective first and second positions [col. 8, lines 39-41]; and a force transmitting member [108 or 105, shown in Fig. 6] operably connecting at least one of the finger loop and the first and second lever members [col. 11, lines 40-44] to a common closable jaw [jaws 14, 16] of the medical device for operating the common closable jaw at a location distant from the handle, where movement of the first and second lever members between the first and second positions, relative to the finger loop, causes movement of the

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common closable jaw for opening and closing the common closable jaw [col. 8, ln. 62 – col. 9, ln. 8]; whereby, in the course of operating the common closable jaw, the first and second lever members are positioned relative to the finger loop so that the operator can reposition the other fingers between the first and second lever members with rotation of the finger within the finger loop while operating the common closable jaw with the finger within the finger loop and thereby assure a comfortable hand posture throughout the complete range of operation of the medical device.

Regarding claim 4, Bacher discloses an upper [40, depending on orientation of the device] finger loop is integral with the first lever member at the free end thereof; and wherein a front [42] finger loop is integral with the second lever member at the free end thereof in Fig. 2.

Response to Arguments

Applicant's arguments, filed 9/2/09, with regards to the Bacher reference have been fully considered but they are not persuasive. Rejections made under the Ferzli reference have been withdrawn in light of applicant's amendments. However, it is further noted that the amendments made to the claims with regards to the common closable jaw caused 112 1st paragraph rejections, seen above.

Applicant argues that the Bacher fails to disclose the first and second lever members causing opening and closing of the common closable jaw when the lever members are moved relative to the finger loop between first and second positions because the levers as disclosed by Bacher are independently movable to actuate distinct first and second jaw parts [14, 16]. However, the examiner interprets the common jaw to be composed of jaw members 14 and 16. Movement of the first and second lever members

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with respect to the finger loop causes movement of elements 14 and 16 relative to each other, effecting an opening and closing motion of the jaw, and thus meeting the claim limitation. There is no claim language which precludes the ability of the first and second lever members to independently move each jaw member of the common jaw.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 20060149222 A1	Okada; Tsutomu	Treatment tool for endoscope
US 6673092 B1	Bacher; Uwe	Medical forceps with two independently moveable jaw parts
US 6533797 B1	Stone; Corbett W. et al.	Control grip assembly
US 6428530 B1	Matern; Ulrich et al.	Grip of endoscopic instrument
US 6394964 B1	Sievert, Jr.; Chester E. et al.	Optical forceps system and method of diagnosing and treating tissue
US 5275613 A	Haber; Terry M. et al.	Endoscopic tissue manipulator
US 5261917 A	Hasson; Harrieth M. et al.	Suture tying forceps with a plurality of suture holders and method of tying a suture

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

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advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTORIA W. CHEN whose telephone number is (571)272-3356. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victoria W Chen/
Examiner, Art Unit 3739

/Linda C Dvorak/
Supervisory Patent Examiner, Art Unit
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